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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,194	06/25/2003	Mark J. Radcliffe	MS1-1547US	5791

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MICROSOFT CORPORATION ONE MICROSOFT WAY REDMOND, WA 98052-6399		

EXAMINER	
MOSSER, KATHLEEN MICHELE	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
11/26/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/607,194

Applicant(s)

RADCLIFFE ET AL.

Examiner

Kathleen Mosser

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 32-41 and 43-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 32-41 and 43-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 3714

DETAILED ACTION

In response to the amendment filed 08/21/2007; claims 1-8, 32-41 and 43-48 are pending.

Claim Objections

1. Claims 8 and 37 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims do not further limit the method steps of the claims from which they rely as they merely recited the method embodied in a computer readable medium.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 38-41 and 43-45 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The preamble of the claims recites "an apparatus for providing audio and lyrical data to a user", however the components of the claims are not drawn to structural components. In claim 38, each of the components (an audio player, a language selection module, a lyric display module, and a lyric editor) are disclosed as being software modules or programs. Similarly, claim 43 recites each of these components in means plus function language. As the means are not clearly identified in the specification, the examiner has interpreted that they are embodied in the same software modules presented in claim 38. As such, the claims are drawn to a computer program or software *per se* and are thus drawn to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8, 35 and 46-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 8 recite a plurality of steps including the feature of selecting an alternate lyric set... when the automatic searching indicates that the lyric set is unavailable in the preferred sublanguage and displaying the alternate lyric set. The method does not provide for any outcome when the searching determines that a lyric set in the preferred language is available. It is unclear as to how the method as claimed is intended to perform given this circumstance. Claims 2-7 inherit this deficiency through their dependency.
4. With respect to claim 35, the system of the present invention includes a very detailed process for determining if a selected preferred language is available for displaying a lyric set. However, claim 35 recites that a user may simply request a change of the language and it will be displayed. It is unclear how the method functions to perform these steps in the context of the alternative language search features of the claimed invention. There are no procedures defined in the claim for determining if the requested language is available. The claim is indefinite in that the claim does not address how the method assures that the requested language is available for display.
5. Claim 46 recites the limitation "the appropriate lyric" in line 21 of the page. There is insufficient antecedent basis for this limitation in the claim. Claims 47 and 48 inherit the deficiency through their dependencies.

Claim Rejections - 35 USC § 103

Art Unit: 3714

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 32, 33, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover et al (US 5469370) in view of Qian et al (US 2002/0193895). Ostrover teaches a method for providing audio and lyrical data to a user including: receiving a user request to play an audio file (col. 2: 38-41); identifying based on the user request, a preferred language for displaying lyrics (col. 3: 16-20); identifying an alternative language from for the lyrics if the preferred language is not available (col. 25: 21-32) and playing the audio data and the lyrics with either the preferred or the alternative lyrics, as needed (see Figures 5A, 5B and 5D). It is noted that process of selecting an alternative language is not automated within the Ostrover process. It has been held that the automation of an otherwise manual practice, when the automation of such a process is within the ordinary skill in the art, is an obvious modification and does not render a claim patentable over the prior art. The process of having a computer system automatically determine an alternative language is akin to having a system switch to a default presentation language when a selected language is not available. The programming required for such a selection process is well within the ordinary skill in the art and thus the automation of the manual process of Ostrover et al is considered prima facie obvious. Ostrover teaches that the use of English if lyric data is not available in the preferred or alternate language (claims 33), see the description of the default language in col. 3: 8-14 and col. 23: 9-13.

Art Unit: 3714

Ostrover does not teach the inclusion of a lyric editor that allows a user to add lyrics to an audio file and edit existing lyrics (claims 32 and 37). Ostrover et al does not explicitly refer to the use of time-codes to be associated with the displaying of lyrical segments (claim 36) or that the lyric data is stored with the audio file (claim 34). The invention of Qian et al is designed to allow a user to edit and create lyric files to be associated with multimedia content (see Figure 18 and its associated description). Qian et al mentions the use of timestamps in paragraph 7 and details the creation of such throughout the specification. It would have been obvious to one of ordinary skill in the art to include the functionality of the Qian et al invention into the Ostrover et al invention so as to allow the user edit and create their captioned multimedia files.

Response to Arguments

Applicant Interview Request

The examiner acknowledges the applicant's request for an interview in the instant application. In reviewing the application file the examiner notes that at least two interviews have already been conducted in the prosecution of the pending application. Further, in view of the substantial changes to the rejection of the claims, an interview prior to the mailing of an action on the merits is denied. However, should applicant, upon review of this action, believe an interview would serve to expedite prosecution, they are invited to contact the examiner at the number mentioned below to discuss the scheduling of such.

Rejections under 35 U.S.C. 112, second paragraph

The previous rejection of claims 8 and 37 under this section are withdrawn. However, the claims remain objected to for the reasons set forth above.

Applicant's arguments, with respect to the rejection(s) of claim(s) based upon the Charlesworth et al reference have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ostrover and Qian.

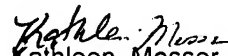
Art Unit: 3714

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kathleen Mosser
Primary Examiner
Art Unit 3714

November 16, 2007